

Attachment to Box II:

The applicants' arguments provided in the interview and remarks filed 01/25/2010 are fully considered but are not found persuasive for the following reasons below:

(A)

Applicants' Argument: Brown does not teach or suggest a "sub-effective amount of at least one dispersant for the inorganic particulate material at completion of the final grinding stage" (see Pages 5-6 of the Applicants' Remarks).

Examiner's Response: While it is true that on page 3, lines 1-9 of the present specification, "a sub-effective amount" is defined as an amount not sufficient to give rise to the deflocculation of the particulate inorganic material, so that the flocculation characteristics are substantially the same as would be found in the complete absence of an dispersant, the applicants further define on page 3, lines 10-15 of the present specification that "such amount of the dispersant may typically be up to about 0.25 % by weight, based on the weight of the dry inorganic particulate, for example up to about 0.15 % by weight, e.g., up to about 0.1 % by weight (emphasis added)." The claims also recite the sub-effective amount of dispersants is up to 0.19% by weight (see, claim 39, for example). Such amount is disclosed by Brown et al. Brown et al. teach using at least 0.1% by weight, based on the weight of dry particulate material, of dispersants (Col. 7, lines 65-67). Brown et al. also disclose that the amount of dispersing agent does not exceed 1.5% by weight (Col. 8, lines 1-3), which overlaps with the "sub-effective amount" of dispersants as claimed and disclosed in the present specification,

see MPEP § 2144.05. Thus, according to the amount claimed and disclosed by the applicants, Brown et al. teach using a “sub-effective amount” of dispersants.

(B)

Applicants' Argument: Brown does not teach or suggest the inorganic particulate at a solids level up to about 35% by weight (see Pages 6-7 of the Applicants' Remarks).

Examiner's Response: On page 3, lines 20-24 of the present specification, the applicants disclose grinding of an inorganic particulate material at a low solids level in the suspension, e.g. the amount of the inorganic particulate solids being less than about 50% by weight, based on the total weight of the suspension. Like the applicants, Brown teaches using, for example, in the preliminary grinding step, a low solids concentration of below 50% by weight with dispersing agents subsequently added (Col. 4, lines 15-20 and Col. 4, lines 20-24), which overlaps with the claimed amount of up to about 35% by weight, see MPEP § 2144.05.

(C)

Applicants' Argument: Skuse and Leighton fail to overcome the deficiencies of the claim rejection based on Brown (see Pages 6 and 8 of the Applicants' Remarks).

Examiner's Response: While Skuse and Leighton do not disclose all the features of the present claimed invention, they are used as teaching references and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention. Rather these references teach a certain concept, and in combination with the other references, disclose the presently claimed invention.

(D)

Applicant's Arguments: (1) The attribute of final grinding stage is inherent and necessarily present in applicants' originally filed disclosure, and thus, it does not constitute new matter, even though it is not explicitly recited in the specification (see Page 4 of the Applicants' Remarks). (2) The claimed range, "up to 35%," is supported because the specification fully describes the range "between 35% and 60%." Thus, no new matter has been added by this particular amendment.

Examiner's Response: (1) The applicants fail to consider that the grinding stage can occur continuously, without a final stage. Thus, the attribute is not necessarily inherent. (2) While it is true that the range between 35% and 60% is supported by the specification, the specification still does not support any amount less than 35%, such as 0-34%. Thus, there is new matter.

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